

REMARKS

Claims 1-49, 51-62 and 64-67 are pending in the above-identified application. Claims 1-4, 6-9, 11, 13-15, 17-20, 22-25, 27, 29-31, 33-36, 38-41, 43, 45-47, 49, 52-54 and 56-67 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian et al. (U.S. Pat. No. 6,820,255; hereinafter referred to as "Babaian") in view of Schwarm et al. (U.S. Pat. No. 6,813,522; hereinafter referred to as "Schwarm"). Claims 5, 21 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm and further in view of Ronstrom (U.S. Pat. No. 6,249,788). Claims 10, 26 and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm and further in view of Miller ("Software Based Instruction Caching for RAW Architecture," 5/1999). Claims 12, 16, 28, 32, 44 and 48 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm and further in view of Nelson et al. (U.S. Pat. No. 5,475,840; hereinafter referred to as "Nelson"). Claims 51 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm.

Claim 68 has been added to include a additional novel aspect of Applicants' disclosure, specifically "translating a second portion of the subject code of the second program into a second portion of the target code" and a "determination that the first cached portion is better than the second portion of the target code." Support for this feature is located in **FIG. 16** and the corresponding description at ¶[0201], including examples of what would constitute "better."

Claims 5, 21, 37, 60 and 62 have been amended to remove unnecessary numbering and lettering. Claims 51 and 52 have been amended because they were dependent upon canceled claim 50. Claims 1, 8, 24, 33, 40, 53-56, 58, 59, 61 and 64-67 have been amended to remove unnecessary wording, specifically the word "step" or the phrase "the steps of." None of these amendments either change the scope of the claims or add new matter. Applicants submit that these amendments and remarks overcome all of the Examiner's outstanding objections and rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

Rejections Based Upon 35 U.S.C. §103(a)

Claims 1-4, 6-9, 11, 13-15, 17-20, 22-25, 27, 29-31, 33-36, 38-41, 43, 45-47, 49, 52-54 and 56-67 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian et al. in view of Swarm.

With respect to independent claims 1, 17, 33 and 49, the current Office Action, dated November 30, 2009, (O.A.) rejects the claims under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Swarm. Simply stated Babaian does not correlate a “first portion of the subject code of a first program” with a “subject code of a second program.” Rather, Babaian establishes that the second foreign code is the same as the first foreign code, i.e. the same program is being translated. This feature is illustrated in the following excerpt:

If the search in step 306 is not successful, software layer 206 calculates a digital signature for foreign code page as indicated at step 310. The digital signature uniquely identifies the binary translated code and may be either a disk sector address or may be calculated using a hashing algorithm. Using the digital signature, software layer 206 searches the database for binary translated code with the same relative entry point and the same signature as indicated at step 312.

(col. 8, lines 27-36; *emphasis added*). In other words, Babaian does not establish compatibility between a first cached portion corresponding to a first program and a second portion of the subject code from a second program.

In addition, the O.A. concedes that “Babaian does not explicitly disclose providing a second translator instance which is different from the first translator instance and which translates the subject code of the second program into the target code, wherein the second translator instance operates simultaneously with the first translator instance” (p. 3, lines 9-12). The O.A. relies upon Swarm for this particular element. However, the translators of Swarm are “address translators for translating logical addresses specified by program instructions to corresponding physical addresses for addressing the memory” (Claim 5). Certainly, Swarm’s translators are not analogous to either of Applicants’ first or second translator

instances and would not suggest to one with skill in the art simultaneous code translation, which is an altogether different issue than address sharing.

The Examiner has provided no justification why one of ordinary skill in the art would further modify the teachings of Baraian or Schwarm to apply to program translation as claimed by Applicants. Simply stated, Baraiam is directed to “increasing efficiency of a binary translation process” (Abstract) while Schwarm is directed to “clon[ing] [code and data] in a multiprocessor in order to permit each processor to run concurrently” (Abstract). These would seem to be unrelated technologies and as such there can be no expectation that one with skill in the art would combine them. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness under either the TSM test applied at the time of the FOA or under the broader obviousness test established in *Graham vs. John Deere* and affirmed in *KSR vs. Teleflex*.” In addition, the elements must be arranged as required by the claim (MPEP §2131, citing *In re Bond*, 910 F.2d 831, (Fed. Cir. 1990)).

Claims 5, 21 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm and further in view of Ronstrom. Claims 10, 26 and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm and further in view of Miller. Claims 12, 16, 28, 32, 44 and 48 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm and further in view of Nelson. Claims 51 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Babaian in view of Schwarm. However, neither Ronstrom, Miller nor Nelson, alone or in combination, provide the elements described above that Baraian and Schwarm lack. Therefore, claims 5, 10, 12, 16, 21, 26, 28, 32, 37, 42, 44, 48, 51 and 55 are allowable as depending upon one of the allowable base claims.

To establish *prima facie* obviousness of a claimed invention under §103(a), all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, “**All words in a claim must be considered** in judging the patentability of that claim against prior art.” (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Applicants believe that the cited art fails to meet this standard. For the reasons above, claims 1-49, 51-62 and 64-67 are allowable over the cited art. In addition

to the reasons stated above, claims 2-16, 18-32, 34-48, 51-62 and 64-67 are allowable because they each depend upon one of the allowable independent claims. Therefore, Applicants respectfully request withdrawal of the §103(a) rejections of claims 1-49, 51-62 and 64-67.

CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. It is believed that no fees are due with the filing of this Amendment/Response. However, should any fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

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